

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

JOHN R. WILSON and WILSON WOLF
MANUFACTURING CORP.

Plaintiffs,

v.

CORNING INCORPORATED

Defendant.

Case No. 13-cv-210-DWF-FLN

**CORNING INCORPORATED’S MOTION FOR
SUMMARY JUDGMENT BASED ON INTERVENING PTAB DECISION**

Defendant Corning Incorporated (“Corning”) hereby moves pursuant to Rule 56 of the Federal Rules of Civil Procedure for summary judgment on all remaining Counts of Plaintiffs’ Complaint. In support of its Motion, Corning submits the accompanying Memorandum of Law and exhibits, and states as follows:

1. On December 26, 2017, the Patent Trial and Appeal Board (“PTAB”) held the supposedly novel claims in John Wilson’s U.S. Patent No. 8,809,044 (the “’044 Patent”) – the same concepts alleged in this case to be Plaintiffs’ “trade secrets” and “confidential information” – to be unpatentable because they were anticipated or obvious in view of the prior art. Specifically, the PTAB found the ‘044 Patent is invalid as anticipated in view of U.S. Patent No. 6,759,245 to Toner (“Toner”), or obvious in view of the combination of Toner and Freshney, R.I., *Culture of Animal Cells: A Manual of Basic Technique*, published in 2000.

2. In this litigation, Plaintiffs assert that the same concepts the PTAB held to be generally known in the prior art are Plaintiffs' alleged "trade secrets," "confidential information" under a confidential disclosure agreement (the "CDA") between Plaintiffs and Corning, and Wilson's inventive contributions to Corning's patents.

3. Having lost before the PTAB, Plaintiffs cannot re-litigate the novelty of these concepts again in this Court. Final decisions by a federal administrative agency should be entitled to preclusive effect in a district court if the decision otherwise meets the requirements for issue preclusion. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015).

Corning therefore respectfully requests that the Court dismiss Plaintiffs' Complaint and enter summary judgment in Corning's favor for the reasons set forth in the accompanying Memorandum of Law and exhibits.

Dated: January 19, 2018

By: /s/ Kimball R. Anderson
Counsel for Corning Incorporated

Kimball R. Anderson (admitted *pro hac vice*)
Winston & Strawn LLP
35 West Wacker Drive
Chicago, IL 60601
312-558-5858
kanderso@winston.com

Paula W. Hinton (admitted *pro hac vice*)
Winston & Strawn LLP
1111 Louisiana Street
Houston, TX 77002-5242
713-651-2663
phinton@winston.com

Howard I. Shin (admitted *pro hac vice*)
Winston & Strawn LLP

200 Park Avenue
New York, NY 10166
212-294-6700
hshin@winston.com

Paul B. Hunt (admitted *pro hac vice*)
Jeff M. Barron (admitted *pro hac vice*)
Barnes & Thornburg, LLP
11 South Meridan Street
Indianapolis, IN 46204-3535
317-236-1313
paul.hunt@btlaw.com
jeff.barron@btlaw.com

Annamarie Daley
MN 158112
Jones Day
90 South Seventh Street, Suite 4950
Minneapolis, MN 55402
612-217-8844
adaley@jonesday.com